REMARKS/ARGUMENTS

1.)   Claim Amendments

Claims 2 and 3 are pending in the application. They have not been amended, but a courtesy copy of the claims is provided above.

2.)   Claim Rejections – 35 U.S.C. § 103 (a)

The Examiner rejected claims 2-3 under 35 U.S.C. § 103(a) as being unpatentable over Mortsolf, et al. (US 6,229,804) in view of Gardell, et al. (US 6,128,304). The Applicant respectfully traverses this rejection.

Not All Elements are Taught:

As stated by the Examiner, Mortsolf discloses a method for establishing a connection between a calling party and a called party in a H.323 Network wherein the gatekeepers are arranged in a hierarchical manner. However, the Examiner admits that Mortsolf does not teach receiving by a first gatekeeper a Set-up command issued from a connected calling user, performing a user location algorithm by said first gatekeeper on its locally attached users, if this algorithm fails, sending a Location Request message to its lower level gatekeepers, wherein each lower level gatekeeper performs an user location algorithm on its attached users and lower level gatekeepers, if these user location algorithms fail, sending a Location Request message to its higher level gatekeeper, which performs an user location algorithm on its attached users and gatekeepers except the originating gatekeeper, if one of the user location algorithms succeeds, the gatekeeper concerned a Location Confirm message to the first gatekeeper, the first gatekeeper sending a Set-up message to the gatekeeper which has issued the Location Confirm message, which gatekeeper forwards said Set-up message to the called user, whereupon said connection is established. According to the Examiner, these elements are taught by Gardell.

Gardell teaches a method and apparatus for providing traditional telecommunications service capabilities in a packet based computer network (Gardell

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Abstract). However, Gardell uses multi-cast messages to locate the gatekeeper that can supply the requested services. As stated in Gardell at Col. 8, lines 55-59:

> The first gatekeeper is then operative to multi-cast a location request (LRQ) signal LRQ (4) to locate the gatekeeper that services the number dialed at the telephone device.

In contrast, claim 2 does not use multi-cast messages to locate the gatekeeper. The relevant portion of claim 2 states:

> *performing a user location algorithm by said first gatekeeper on its locally attached users,*
> if this algorithm fails, sending a Location Request message to its lower level gatekeepers, wherein each lower level gatekeeper performs an user location algorithm on its attached users and lower level gatekeepers,
> if these user location algorithms fail, sending a Location Request message to its higher level gatekeeper, which performs an user location algorithm on its attached users and gatekeepers except the originating gatekeeper,

Thus, claim 2 uses a user location algorithm to locate desired gatekeeper. Only if and when the location algorithm fails, does the method proceed to the following steps of sending a Location Request message to lower level and upper level gatekeepers. Thus, claim 2 has elements which are not taught by Gardell or Mortsolf.

The MPEP § 2143 states:

> To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations.*

Therefore, with respect to claim 2, to sustain this rejection the combination of Gardell and Mortsolf must contain _all_ of the above claimed elements of the claim. However, neither reference teaches *performing a user location algorithm by said first gatekeeper on its locally attached users.*

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Gardell teaches away from the present disclosure

Furthermore, the Applicant respectfully submits that Gardell actually teaches away from the Applicant's disclosure, and so cannot be used to establish obviousness. Gardell is directed to using multicast location requests to locate the desired gatekeeper (Gardell, col. 8, lines 55-57).   This is in direct contrast to Applicant's claimed invention, which is designed to eliminate (or at least minimize) the use of multicast messages. Therefore, Gardell's method has no direct relevance to the claimed invention. As such, Applicant respectfully submits that one skilled in the art following the teaching of Gardell would not be lead to implement the Applicant's novel approach.

There is no Motivation to Combine the References:

According to MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or _motivation_ to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. _In re Mills_, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Obviousness cannot be established by combining references "without also providing _evidence of the motivating force_ which would impel one skilled in the art to do what the patent applicant has done." MPEP 2144, quoting from _Ex parte Levengood_, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993). "Broad conclusory statements regarding the teaching of multiple references, standing alone are not "evidence." _See_ _Dembiczak_, 50 USPQ2d, 1614, (Fed. Cir. 1999).

Thus, the case law is clear that _there must be evidence_ that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. It is also clear that a rejection cannot be predicated on the mere identification of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge

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of the claimed invention, would have selected these components for combination in the manner claimed. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000).

The Examiner admits that the Mortsolf does not contain the elements of the claims with regard to the *performing a user location algorithm by said first gatekeeper on its locally attached users*. Furthermore, this element is not taught by Gardell, which as discussed above, actually teaches away from this element.

The Examiner states that "with the motivation to provide for a communication system that provides for a communication between a packet based network and a conventional circuit network." However, there is nothing in the Examiner's statements which suggests that combining Mortsolf with Gardell would motivate one skilled in the art to develop a device which would "*performing a user location algorithm by said first gatekeeper on its locally attached users*, if this algorithm fails, sending a Location Request message to its lower level gatekeepers, wherein each lower level gatekeeper performs an user location algorithm on its attached users and lower level gatekeepers, if these user location algorithms fail, sending a Location Request message to its higher level gatekeeper, which performs an user location algorithm on its attached users and gatekeepers except the originating gatekeeper," Thus, it is respectfully asserted that there has been no "evidence" presented of a motivation to combine the references to arrive at the claimed combination.

The case law makes it clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. *See Dembiczak*, 50 USPQ2d, 1614, 1617 (Fed. Cir. 1999). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight." *Id.* It is respectfully submitted that the only way Mortsolf and Gardell could be pieced together to defeat patentability is indeed to use Applicant's disclosure as a blueprint.
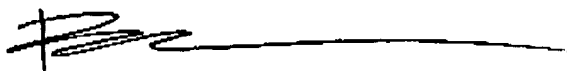
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Thus, the Applicant respectfully requests that the Examiner withdraw the rejection of claim 2. Additionally, claim 3 is patentable for the same reasons that claim 2 is patentable.

CONCLUSION

In view of the foregoing remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for all pending claims.

The Applicant requests a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,

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